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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/875,547   | 06/05/2001  | Dan Kikinis          | 007287.00008        | 6896             |
| 22907 7590 04/29/2008<br>BANNER & WITCOFF, LTD.<br>1100 13th STREET, N.W.<br>SUITE 1200<br>WASHINGTON, DC 20005-4051 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| SALTARELLI, DOMINIC D  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/875,547

**Applicant(s)**

KIKINIS, DAN

**Examiner**

DOMINIC D. SALTARELLI

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-8, 11-15 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8, 11-15 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed February 26, 2008 have been fully considered but they are not persuasive.

Applicant argues that Shintani's intelligent remote control unit does not serve as a passive device for controlling a cable box (applicant's remarks, page 6).

In response, Shintani teaches that one of the function of the intelligent remote control unit is to serve as a passive device for controlling a cable box in addition to other features. See Shintani, col. 3, lines 21-29, which reads "The intelligent remote control unit 10 is a portable terminal (such as a personal digital assistant PDA or a personal intelligent communicator PIC), **and transmits various commands to the cable box 1...**"

Applicant further argues that the stated motivation for combining Shintani with Hassell, the addition of beneficial features provided by Shintani's intelligent remote control unit, is not related to the subject matter of the present invention and does not serve as proper motivation (applicant's remarks, page 7).

In response, that the features which make Shintani's intelligent remote control unit desirable are unrelated to the subject matter of a method for transferring information between memory devices is irrelevant. That there was a motivation to do so that does not require undue experimentation and carries a

reasonable expectation of success is that that is required to satisfy the test of obviousness, which Shintani provides.

Lastly, applicant argues that neither Hassell nor Shintani disclose the feature of a single pressing of a selected portion of one of the personal digital assistant and web phone (applicant's remarks, page 7).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Hassell teaches an interface where the single pressing of a button initiates the claimed transfer of programming from a first to second storage device (Hassell's "transfer key"). The modification of Hassell in view of Shintani places this transfer key on the intelligent remote control unit, so therefore the combination of Hassell and Shintani teaches "a single pressing of a selected portion of the personal digital assistant".

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 and 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program product can only be

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rendered statutory if it is encoded upon a computer readable medium (as opposed to a machine readable medium). Further, paragraph 0032 of the originally filed specification defines 'machine readable-medium' as inclusive of propagated signals. Signals, *per se*, are non-statutory subject matter. The applicant is advised to amend the claims such that claim 8 reads "a computer readable medium encoded with instructions", and to further amend the specification such that said medium is not, and cannot be considered a signal, *per se*.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-8, 11-15, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. (US 2004/0128685 A1, of record) [Hassell] in view of Shintani (5,668,591, of record).

Regarding claims 1, 8, and 15, Hassell discloses a method (and corresponding system) comprising:

displaying an electronic programming guide (figs. 5a-b);

receiving, at a set top box (STB), input corresponding to an actuation of a command and transferring a program from a first storage device of the STB to a second storage device (see the last sentence of paragraph 9) in response to the

actuation (paragraphs 19-21, and 81, wherein actuation of the "transfer" key causes the system to transfer a selected program to another volume, where the first and second storage devices [volumes] consist of removable discs, see paragraph 89).

Hassell fails to disclose the actuation includes a single pressing of a selected portion of a personal digital assistant.

In an analogous art, Shintani teaches using a personal digital assistant to transmit commands to a set top box (cable box 1), where using such a type of intelligent remote control unit also allows a user to engage in more interactive functions (col. 3, lines 16-36).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method, machine readable medium, and system disclosed by Hassell to use a personal digital assistant as the associated remote control [would thus include the disclosed "transfer" key as found on the remote control disclosed by Hassell], as taught by Shintani, providing the benefit of allowing a user to engage in more interactive functions, like games, home shopping, banking, and the like.

Regarding claims 4, 11, and 18, Hassell and Shintani disclose the method, machine readable medium, and system of claims 1, 8, and 15, wherein in response to a second input corresponding to a second actuation of a second command, transferring the program from the second storage device to the first

storage device of the STB, wherein the second actuation corresponds to a pressing of a second portion of the personal digital assistant (a user is provided with the means to transfer programs between volumes at will using the "transfer" key, see paragraphs 9 and 81).

Regarding claims 5, 12, and 19, Hassell and Shintani disclose the method, machine readable medium, and system of claims 4, 11, and 18, and further discloses maintaining an index of programs and related auxiliary data transferred from the first storage device to the second storage device (paragraphs 85-86).

Regarding claims 6, 13, and 20, Hassell and Shintani disclose the method, machine readable medium, and system of claims 5, 12, and 19, wherein the second storage device is a removable storage device (paragraph 85), and in response to a user selecting the program transferred on to the removable storage device, the STB prompts for the insertion of the removable storage device into the STB (paragraph 89).

Regarding claims 7, 14, and 21, Hassell and Shintani disclose the method, machine readable medium, and system of claims 6, 14, and 20, wherein the removable storage device is a DVD-RAM (paragraph 20).

Regarding claim 22, Hassell and Shintani disclose the method of claim 4, wherein the second actuation corresponds to a single pressing of a transfer function button on the remote control (the personal digital assistant is the remote control, see Shintani, col. 3, lines 16-36).

Regarding claim 23, Hassell and Shintani disclose the method of claim 4, wherein the first portion and the second portion are the same portion (the 'transfer' key is the common portion used in transferring programs from one location to another, see Hassell, paragraph 81).

Regarding claim 24, Hassell and Shintani disclose the system of claim 15, wherein Hassell discloses the STB to include a tuner (to perform the channel tuning operation, paragraph 19); a signal input (fig. 2, input 26); a storage medium (fig. 2, digital storage device 31); a processor (an inherent feature of the disclosed STB, which is necessary to control the operations ascribed to the STB); a digital video encoder and decoder (the encoder for converting the program to a desired format, see paragraph 82, where the destination for storage is a digital medium, see paragraph 85, and the decoder for outputting program content to a television, see paragraph 22); and a digital output port (for outputting digital signals on a digital bus, see paragraph 19).

### ***Conclusion***



5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DOMINIC D. SALTARELLI** whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2623

/Dominic D Saltarelli/  
Examiner, Art Unit 2623